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Remarks

Claims 1-22 have been rejected under 35 U.S.C. §103 as being unpatentable over Suzuki, USPN 5,808,722, used as a teaching of a decoder that decodes SD audio and SD video, in view of Yap et al., USPP 2001/0052130, used as a teaching of a device that decodes HD audio. Neither reference mentions that the same device is used to decode more than one audio format.

In contrast, Claim 1, for example, requires decoding both HD audio and SD audio in a first device. Since neither reference suggests this, combining the references in accordance with what they actually teach would result in using two audio decoders, namely, Suzuki's SD audio decoder and Yap's alleged HD audio decoder. The proffered suggestion to alter the references in a way that neither teaches - "to allow users to upgrade to the highest quality video available" - does not address *audio* and in any case does not come from the prior art but from hindsight reasoning using the present claims as a template. The rejections are overcome.

Furthermore, "to render a later invention unpatentable for obviousness, the prior art must enable the later invention", noting that the question wasn't whether the prior art enabled itself but rather whether it enabled the invention being rejected, In re Kumar, 418 F.3d 1361 (Fed. Cir. 2005). Since neither reference appears to teach decoding two kinds of audio in one device, the present claims are not enabled by the prior art and hence are patentable over it.


The Examiner is cordially invited to telephone the undersigned at (619) 338-8075 for any reason which would advance the instant application to allowance.

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